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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,805	06/13/2005	Raymond Puffer	12834-00009-US	1169
23416 7590 01/09/2009 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
EXAMINER				
CANTELMO, GREGG				
ART UNIT		PAPER NUMBER		
1795				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,805

Applicant(s)

PUFFER ET AL.

Examiner

Gregg Cantelmo

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 and 34-61 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 and 34-61 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

1. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

NOTE: The original claim listing and amended claim listing are improperly numbered since there is no claim 33. The restriction requirement is commensurate with the original claim numbering and Applicant is advised to correct the claim numbering in response to this action.

Group I claims, claim(s) 1-13, 15-30, 32, 34 53, 54, and 56 drawn to a method and apparatus for transferring a film.

Group II, claim(s) 14, 31, 35, 36 and 61 drawn to a method and apparatus for feeding a fuel cell membrane to a fuel cell electrode.

Group III, claim(s) 37-45, 55 and 57-60 drawn to a thin film handling device and method for handling thin films.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

- a. The invention of Group I to the method and apparatus for transferring thin films and the invention of Group II fail to share the same special technical features, notably the apparatus and method of Group II is directed to fuel cells which is a special technical feature not shared with the invention of Group I. Likewise the invention of Group I need not transfer a membrane as required by Group II. Also, the invention of Group I does not require the arcuate surface or vacuum table of Group II.
- b. The invention of Group I to the method and apparatus for transferring thin films and the invention of Group III fail to share the same special technical

features. For example, the two inventions are drawn to materially distinct inventions (Group I to a method and apparatus for transferring thin films and Group III to a method and apparatus for handling thin films) and as can be seen from the body of the claims the features therein are mutually divergent and patentably distinct. For example the invention of Group I recites positioning, attaching, moving and transferring of the film all of the steps and apparatus features for achieving this are not required in the invention of Group III. Likewise, the method and apparatus of Group III require a perforated mounting surface a vacuum and moving the perforated surface, all of which are not required in the invention of Group I.

c. The invention of Group II to the method and apparatus for transferring thin films and the invention of Group III fail to share the same special technical features. For example, the two inventions are drawn to materially distinct inventions (Group I to a method and apparatus for transferring a fuel cell membrane to a fuel cell electrode and Group III to a method and apparatus for handling thin films) and as can be seen from the body of the claims the features therein are mutually divergent and patentably distinct. For example the invention of Group II recites the fuel cell membrane and electrode features as well as positioning, attaching, moving and transferring of the film all of the steps and apparatus features for achieving this are not required in the invention of Group III. Likewise, the method and apparatus of Group III require a perforated mounting surface a vacuum and moving the perforated surface, all of which are not required in the invention of Group II.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The following species requirements are as follows:

2. Upon election of Group I, the following species requirements are

presented:

- a. Claims 2-3, 16 and 17 wherein the thin film is provided in a container;
- b. Claims 4, 5 and 18-19 wherein the source position comprises a translatable position;

- c. Claims 6, 8, 9, 20 and 24-26 wherein a surface is connected to a vacuum source;
- d. Claims 7 and 21-23 wherein the first surface is a rotating arcuate surface;
- e. Claims 10, 28-29 and 56 wherein the second surface comprises a release mechanism;
- f. Claims 11 and 30 wherein the thin film is a membrane;
- g. Claims 12-13 and 32 and 34 wherein the film is provided in a viscous solution;
- h. Claim 27 wherein the moving means comprises automated manipulators;
- i. Claims 53 and 54 wherein the second surface is a perforated surface which is connected to a pressurized gas source.

It is further noted that the particular membrane limitations bear no impact on the claimed apparatus since the film is not a positive component of the apparatus but instead is manipulated by the apparatus.

The claims are deemed to correspond to the species listed above in the following manner:

The following claim(s) are generic: the independent claims 1 and 15.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Each species set forth above recites particular special technical features which are distinct from one another for the particular special features identified in each species.

- a. Claims 2-3, 16 and 17 wherein the thin film is provided in a container;
- b. Claims 4, 5 and 18-19 wherein the source position comprises a translatable position;

- c. Claims 6, 8, 9, 20 and 24-26 wherein a surface is connected to a vacuum source;
- d. Claims 7 and 21-23 wherein the first surface is a rotating arcuate surface;
- e. Claims 10, 28-29 and 56 wherein the second surface comprises a release mechanism;
- f. Claims 11 and 30 wherein the thin film is a membrane;
- g. Claims 12-13 and 32 and 34 wherein the film is provided in a viscous solution;
- h. Claim 27 wherein the moving means comprises automated manipulators;
- i. Claims 53 and 54 wherein the second surface is a perforated surface which is connected to a pressurized gas source.

In each instance above the special feature of species a: thin film is provided in a container is not present in any of the remaining species. Similarly the special features of species b-i are not present in any of the other species in Group I.

3. Upon election of Group II, the following species requirements are presented:

- a. Claims 14, 31 and 35 to a method and apparatus for transferring a fuel cell membrane;
- b. Claim 36 to an apparatus for transferring a fuel cell membrane from a container;
- c. Claim 61 to a method for handling fuel cell membranes;

The claims are deemed to correspond to the species listed above in the following manner:

The following claim(s) are generic: none.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Each species set forth above recites particular special technical features which are distinct from one another for the particular special features identified in each species as identified above.

In each instance above the special feature of species b: thin film is provided in a container is not present in any of the remaining species. Similarly the special features of species a and c are not present in any of the other species in Group II.

4. Upon election of Group III, the following species requirements are presented:

- a. Claims 37-52 to an apparatus and method for handling a thin film;
- b. Claims 57-60 to a method for handling a thin film provided in a container

having a top and a bottom.

The claims are deemed to correspond to the species listed above in the following manner:

The following claim(s) are generic: none.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Each species set forth above recites particular special technical features which are distinct from one another for the particular special features identified in each species as identified above.

In each instance above the special feature of species b: thin film is provided in a container is not present in species a.

Upon election of species "a" for group III, the following additional species requirements are presented

- a. Claims 38-41, 47-48 wherein the perforated surface is a rotating arcuate surface;
- b. Claims 42 and 47 wherein the perforated surface is a planar surface;

- c. Claims 43-45 and 51-52 wherein the perforated surface comprises means for dislodging the thin film;
- d. Claim 49 wherein the surface comprising a translating component;
- e. Claim 50 wherein the moving surface comprises rotating;
- f. Claim 55 further comprising means for pressuring the plenum.

The claims are deemed to correspond to the species listed above in the following manner:

The following claim(s) are generic: 37 and 46.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Each species set forth above recites particular special technical features which are distinct from one another for the particular special features identified in each species as identified above.

- a. Claims 38-41, 47-48 wherein the perforated surface is a rotating arcuate surface;
- b. Claims 42 and 47 wherein the perforated surface is a planar surface;
- c. Claims 43-45 and 51-52 wherein the perforated surface comprises means for dislodging the thin film;
- d. Claim 49 wherein the surface comprising a translating component;
- e. Claim 50 wherein the moving surface comprises rotating;
- f. Claim 55 further comprising means for pressuring the plenum.

In each instance above the special feature of species a: wherein the perforated surface is a rotating arcuate surface is not present in any of the remaining species b-f. Similarly the special features of species b-f are not present in any of the other species in Group IIIa.

5. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

6. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregg Cantelmo/
Primary Examiner, Art Unit 1795